







# Supreme Court of the United States

October Term, 1938.

No. 3.

THE SCHRIBER-SCHROTH COMPANY, Petitioner,

v.

THE CLEVELAND TRUST COMPANY, CHRYSLER CORPORATION,  
Respondents.

No. 4.

THE ABERDEEN MOTOR SUPPLY COMPANY, Petitioner,

v.

THE CLEVELAND TRUST COMPANY, CHRYSLER CORPORATION,  
Respondents.

No. 5.

THE F. E. ROWE SALES COMPANY, Petitioner,

v.

THE CLEVELAND TRUST COMPANY, CHRYSLER CORPORATION,  
Respondents.

PETITIONER'S ANSWER TO RESPONDENT'S MOTION TO AMEND THIS COURT'S OPINION OR IN THE ALTERNATIVE FOR A REHEARING.

## I. As To Amending The Court's Opinion:

The amendments sought are (1) an expansion of the remanding clause so as to give explicit directions to the court below in three particulars rather than the general directions

which are usually given to proceed in conformity with the opinion of this Court, and (2) to correct some alleged errors in the opinion.

(1) We see no reason for these explicit directions other than to lay a foundation for respondent to argue before the court below that this court intended that it should reconsider the patentability of a combination which does not include webs laterally flexible, and which combination that court clearly indicated was not patentable *in view of the prior art*. The request by respondents is plainly an effort to avoid the effect of this Court's discussion of the prior art on page 4 of the opinion.

In addition to the prior art referred to in the opinion of this Court, it will be remembered that all of the claims of the Gulick patent were rejected on January 30, 1922, by the Patent Office, in view of some of the prior art referred to by this Court. Thereupon, the specification was altered to incorporate the feature of webs laterally flexible<sup>1</sup> and it was on that basis that the patent was eventually allowed.

It is contended that the court below could not have considered that webs laterally flexible was an element of such of the claims of the Gulick patent as did not contain it *specifically* and of the claims of the Maynard patent because of the statement in *McCarthy v. Lehigh*, 160 U. S. 110. Whether the court below was conscious of that rule or not is of no moment. It did specifically refer to webs laterally flexible as one of the elements of the invention and it indicated clearly that without such an element there was no patentable invention. Therefore, the only reasonable assumption that this Court could make, either as to claim 1 of the Gulick patent or any claim of either patent which does not specifically mention webs laterally flexible, was that the court below had read (in the sense of interpreting or limiting the broad language used in the claims to describe the webs) that element into the claims in order to

<sup>1</sup> R. Vol. IV, pp. 1865-66.

save them. It is well settled that a specification may be referred to in order to interpret a claim or limit it in order to save it<sup>8</sup> and that the phrase "substantially as described" is always implied in claims even though not expressed.<sup>9</sup>

In *Mantle Lamp Co. v. Bowman Co.*, 53 F. (2d) 441, the Circuit Court of Appeals for the Sixth Circuit, consisting of Judges Denison, Moorman and Simons, referring to the patent then before the court, said (p. 444):

"We think also that the always implied 'substantially as described', and the doctrine of interpretation by the specifications; justify regarding the 'bond' of the claim as one which does effectively insulate the outer and inner members. The patent specifies, in line 61 of page 1, that the bonding substance shall be of low heat conductivity, and the succeeding lines emphasize that it is to be incapable of transferring much heat or cold from one to the other. Its 'non-heat transmitting properties' are again emphasized in line 115 of page 2. To import this limitation into the claim is not to bring in an additional element. It is only to interpret with the aid of the specification one of the words of the claim, so that it may not be thought so broad as to be destructive."<sup>10</sup>

In the case at bar, all of the claims of the Gulick and Maynard patents in suit, which do not specifically mention webs laterally flexible, refer to the connection between the bosses and the skirt in varying language.<sup>11</sup> This is, of

<sup>8</sup> See Walker on Patents (Deller's Edition), Vol. II, §261, p. 1242, and cases there cited.

<sup>9</sup> See Walker on Patents (Deller's Edition), Vol. II, §272, p. 1284, and cases there cited.

<sup>10</sup> When emphasis is used in quotations it will be understood that the emphasis is supplied unless otherwise indicated.

<sup>11</sup> *Gulick Patent*:

*Claim 1:* The words are "connected to the head and to the upper and lower parts of the skirt"; *Claims 11 and 12:* "connecting flanges in the zone of the bosses, and extending from the

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course, the web. To construe this connection or web as flexible is, to use the language in the case last cited—"not to bring in an additional element. It is only to interpret with the aid of the specification one of the words of the claim. \* \* \* \*

In *McCarthy v. Lehigh*, *supra*, the rule above stated is fully recognized. See the part beginning on page 116 and preceding the statement of the rule which is incorporated in the headnote quoted on page 4 of respondents' motion. This Court, in *American Fruit Growers, Inc., v. Brogdex, Inc.*, 283 U. S. 1, 6, said:

"The claim of a patent must always be explained by and read in connection with the specification."

The argument that the court below could not have predicated patentability upon the novelty of any one element of the combination simply raises a "straw man." This Court specifically held (opinion p. 5) that "the court below found invention in the Gulick disclosure in a combination of elements, of which one was "webs laterally flexible" \* \* \*." It is, of course, a well settled rule as stated in the motion (p. 8) that patentable invention may be found in a combination of old elements alone\* or in a combination of old ele-

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bosses to the skirt \* \* \*"; claim 13: "separated pin bosses having integral flanges connecting them with the skirt"; claim 15: "said integrally uniting said bosses, the guide portion \* \* \*"; claim 18: "a pair of spaced webs, each of which connects one of said bosses to said cylinder-engaging parts \* \* \*"; claim 30: "tying means extending from each of said wrist pin bearings \* \* \*"; claim 33: "means integrally connecting each boss to both of said opposite main bearing portions."

*Meynard Patent:*

Claim 1: "webs on diametrically opposite sides of the piston \* \* \*"; claim 6: "a plurality of webs integral with said head \* \* \*"; claim 8: "a pair of substantially rectangular shaped webs \* \* \*"

\* *Loom Co. v. Higgins*, 105 U. S. 580 and many other cases.

ments and one or more new elements.' Before the amendment which brought in the lateral flexibility of the webs, the Patent Office held that the old combination did not constitute invention. That the court below reached the same conclusion seems to be clear from its opinion. The combination which included the new element was what the court of appeals held to constitute the invention.

It is urged further that this Court should direct the lower court to apply the same rule to test the sufficiency of prior art disclosures which this Court has applied to the Maynard patent. Why any such direction should be given we are unable to see. The rules of construction of prior art items and the extent and sufficiency of disclosures therein are, of course, well settled. Some of the authorities are collected in Respondents' Motion, pp. 11-13. Any such direction as is asked for might readily be confusing. Every patent or other written disclosure must be construed according to the language used, with due regard to the rule that they are addressed to persons skilled in the art.

Moreover, there is nothing to show that the court below interpreted the disclosures of the prior art differently than this Court interpreted the Gulick disclosures as originally filed and the Maynard disclosures as issued. As we understand the opinion this Court applied neither a "liberal" nor a "strict" rule. It simply held that when Gulick said in his original specification that the webs provided "an extremely rigid connection between the piston pin bosses and the skirt" and made other statements to the same effect, it was not permissible for him to thereafter change the specifications so as to describe such webs as flexible, especially in the light of the testimony of respondents' own expert to the effect that inherent flexibility cannot be depended upon in the absence of correct proportioning of the different parts. So far as Maynard is concerned, it is not

<sup>1</sup> *Leeds & Catlin v. Victor*, 213 U. S. 301, 330; *Lyman Mfg. Co. v. Bassick Mfg. Co.*, 18 F. (2d) 29, 33 (C. C. A. 6th—Judge Denison).

disputed that there is not a word in the specifications about the webs being laterally flexible. These considerations make a discussion of the prior art referred to by respondent unnecessary and, indeed, out of place.

Quite apart from what has been said, respondent cannot complain of the remanding part of this Court's opinion because this Court would have been fully justified in directing that the court below treat the Gulick patent as invalid because of the amendment made to the specification. We now urge the Court to do so.<sup>6</sup> The specification of the Gulick patent as now issued contains an amendment which this Court has held it was not permissible to make because there was no basis for it in the specification as originally filed. Rule 70 of the Patent Office is as follows (p. 998):

"In original applications all amendments of the drawings or specifications, and all additions thereto, must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from the original invention, can not be added to the application even though supported by a supplemental oath, and can be shown or claimed only in a separate application."

Consequently, if the decision of this Court had been before the Patent Office, the patent could not have issued with the amendment. As previously stated, the amendment was deemed essential for the allowance of the patent. It must logically follow, therefore, that the amendment has invalidated the patent *in toto*. This is, as we construe it, what was held by this Court in *Powers-Kennedy v. Concrete Co.*, 282 U. S. 175, 185. In the case of *American Bell Tel. Co. v. National Tel. Mfg. Co.*, 109 Fed. 976, 1005 (C. C. Mass.), the reason why an improper change in the specification should invalidate the whole patent is thus stated:

"I am of the opinion that this patent is invalid for the reasons that the power to amend an application

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<sup>6</sup> This Court is also justified in holding the Maynard patent invalid because, without the flexible web element, it did not exhibit any invention over the prior art.

does not include the power to change the nature of the invention; that the right to amend or the right to complete an application under section 4894, Rev. St. U. S., does not give the right to transform completely; that the only remedy for a radical mistake in substance so serious as to require a transformation so complete as is here shown is a new application."

The amendment to the Gulick Application was not only to the claims but to the description by changing "extremely rigid" to "laterally flexible." This not only changed the description of the structure but also the principle of operation. The specification does not comply with R. S. 4888, 35 USC 33, because it does not contain "a written description" of the Gulick piston as filed and does not "explain the principle thereof and the best mode in which he has contemplated applying that principle." The patent is, therefore, just as void as if it had never contained a written description or had never explained the principle.

Moreover, the rule is abundantly settled that claims predicated upon unlawful amendments to the specifications are invalid. *Insulite Co. v. Reserve Supply Co.*, 60 F. (2d) 433 (C. C. A. 8); *Boyce v. Stewart-Warner Speedometer Corporation*, 220 F. 123 (C. C. A. 2nd); *Standard Oil Development Co. v. James B. Berry Sons Co., Inc.*, 92 F. (2d) 386 (C. C. A. 3rd); *Kwik-Set v. Welch Grape Juice Co.*, 14 Fed. Supp. 137; Rev'd on other grounds, 86 Fed. 945; *The Chicago and Northwestern Railway Company v. Thomas Sayles*, 97 U. S. 554; *Eagle Mfg. Co. v. West, Bradley & Cary Mfg. Co., et al.*, 111 U. S. 490; *Western Electric Co. v. Wallerstein*, 51 F. (2d) 529; *Pomeroy v. Walker*, 64 F. (2d) 544; *Bonnot Co. v. Lopulco Systems*, 15 F. (2d) 848.

As the Patent Office refused allowance of any claims before the amendment, and since any claim which does not expressly or impliedly contain the subject matter of the amendment, was plainly foreshadowed by the prior art, it necessarily follows that the whole patent must be invalid, because a patent without valid claims is a legal impossibility.

ity. Whether the defect in the patent may be cured by disclaimer or reissue we need not now consider.

*(2) Suggested Corrections.*

We will discuss the suggested amendments of the opinion with reference to the letters used in respondents' motion (pp. 18-20).

(a) The statement in this Court's opinion as to claims 18 and 33, we think is entirely accurate. One of the elements "whereby said skirt is yieldable" (claim 18) is "a pair of spaced walls" (p. 3, line 117). These walls are the laterally flexible webs. Webs are treated as synonymous with walls in this Court's opinion on page 3.<sup>8</sup> They are also thus referred to in the patent, page 1, line 63.

The portion of claim 33 quoted in the motion recites only part of the elements that render the skirt wall yieldable. One of the other elements is "means integrally connecting each boss to both main bearing portions". This latter is, of course, the lateral webs.

(b) The alleged mistake referred to under (b) is immaterial. The fact is that the pooling agreement involves only one individual inventor, an automobile manufacturer and several manufacturers of aluminum pistons.

(c) The part of the opinion referred to under (c) is entirely correct. We refer to this under the next point.

*II. As To The Rehearing:*

We will answer the petition with reference to the subject matter under "A" and "B" of the petition, respectively.

**A.**

(a) We have already answered the grounds advanced in paragraphs 1, 2 and 4.

<sup>8</sup> "The piston head and skirt are connected by two 'webs' or walls extending longitudinally through the interior of the skirt".

(b) There is nothing in the evidence to show that the drawings of either the Gulick or Maynard patents are to scale, and this Court so found (Opinion, p. 6). As a general rule, patent drawings are not to scale. At any rate, this whole matter has been fully discussed in respondents' brief and our reply brief (See the latter, pp. 8-10; Resps. Br. pp. 34-35).

B.

(a) This Court is now asked to change its conclusion that there was not a sufficient basis in the Gulick application as filed to justify the amendment that was made. The contention is that certain articles appearing in publications referred to in the record are not more explicit "to teach those skilled in the art how to make the pistons illustrated and described in these articles and how to operate them to make their principles available to the public" than the specifications of the patent in suit. Initially, it should be noted that none of these articles are relied upon by either this Court or the court below as part of the prior art. It is, therefore, quite impossible to see the relevancy of the present contention. But quite apart from that, the amendment was unlawful because its language was the very antithesis of that used in the specification as originally filed. This was considered and fully discussed by this Court (p. 8 of Opinion).

It is respectfully submitted that the motion should be denied.

Respectfully submitted,

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December 8, 1938.